



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,462	09/18/2001	Jeffrey Wilusz	601-1-109N	7730
34055	7590	03/08/2004	EXAMINER	
PERKINS COIE LLP POST OFFICE BOX 1208 SEATTLE, WA 98111-1208			LAMBERTSON, DAVID A	
			ART UNIT	PAPER NUMBER

1636

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

# Office Action Summary

Application No.

09/955,462

Applicant(s)

WILUSZ ET AL.

Examiner

David A. Lambertson

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,9-13,17,19,20 and 27-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5,6,9,11-13,17,19 and 27-43 is/are allowed.
- 6) ☒ Claim(s) 10 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

Receipt is acknowledged of a reply to the previous Office Action, filed December 11, 2003. Amendments were made to the claims.

Claims 1-3, 5, 6, 9-13, 17, 19, 20 and 27-43 are pending and under consideration in the instant application. Any rejection of record in the previous Office Action, mailed August 11, 2003, that is not addressed in this action has been withdrawn.

### ***Specification***

The disclosure is objected to because of the following informalities: page 52 of the specification contains an informal sequence listing that is not in the proper format. Cancellation of this information would be remedial, in view of the fact that a properly formatted sequence listing was subsequently filed and entered into the specification.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 20 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to recite a proper Markush group. In order for the claims to be definite, they must recite the proper Markush language, wherein the members of the

Art Unit: 1636

Markush group are "selected from the group consisting of", followed by the listing of the members of the group. In addition, the conjunction "and" must follow the penultimate member of the group. In the instant case, the claims have both conjunctions "or" and "and" present in the claim language. This makes the claim indefinite because it is unclear if the selection is made from either (a) the whole collection of a radioactive label, a non-radioactive isotopic label, a fluorescent moiety, a visibly-detectable moiety and a releasable substrate or (b) a co-factor for a chemical and enzymatic reaction, or if each of the individual items is a single group (i.e., pick one from either (a) or (b) set forth above). It would be remedial to indicate the following language, if the latter is true: "... wherein said cap-labeled mRNA substrate is labeled at the cap of said cap-labeled mRNA substrate by a label selected from the group consisting of a radioactive label, a non-radioactive isotopic label, a fluorescent moiety, a visibly-detectable moiety, a releasable substrate, a co-factor for a chemical reaction, and a co-factor for an enzymatic reaction."

***Allowable Subject Matter***

Claims 1-3, 5, 6, 9, 11-13, 17, 19 and 27-43 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone

Art Unit: 1636

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.  
AU 1636



JAMES KETTER  
PRIMARY EXAMINER